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EXAMINER

HUFFMAN, JULIAN D

ART UNIT	PAPER NUMBER
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2853

DATE MAILED: 03/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/888,215

Applicant(s)

STEVENS, CHAD A.

Examiner

Julian D. Huffman

Art Unit

2853

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,9,10,12-19 and 25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,9,10,12-19 and 25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 16-19 and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The disclosure does not support the elements packaged together in a kit.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. With regards to claims 12-14, Floegel et al. disclose an electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium (element 12);

an electrostatic charge deposited on a side of said sticker print medium (column 3, lines 11-15);

a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium (element 14);

wherein said sticker print medium is made of vinyl (column 4, lines 61-62); and

wherein said sticker print medium is transparent (column 1, lines 29-35).

5. Claims 12-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Longtin (U.S. 5,334,431).

Longtin discloses an electrostatic sticker print medium for use with a printer, said sticker print medium comprising:

a blank sheet of electrostatic print medium (the sticker was inherently blank before it was printed upon);

an electrostatic charge deposited on a side of said sticker print medium (column 3, lines 6-9); and

a protective backing over said electrostatic charge on said blank sheet of electrostatic print medium (fig. 1, element 20, column 1, lines 22-31);

wherein said sticker print medium is made of transparent vinyl (column 3, lines 8-10 and 15-16);

wherein the sheet is perforated to define a plurality of sticker panes (fig. 1).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain.

Floegel et al. disclose a method of making a user-customized electrostatic sticker, said method comprising:

printing a user-selected image on sticker print medium (column 1, lines 13-16), said sticker print medium being of a non-conductive material on which an electrostatic charge can be maintained such that said sticker print medium functions as an electrostatic sticker (column 1, lines 56-58 and column 2, lines 30-32);

depositing an electrostatic charge on said sticker print medium with a charge donor (column 3, lines 11-14);

applying said sticker such that a side of said sticker bearing said electrostatic charge is in contact with a surface to which said sticker is applied (column 4, lines 39-40, both sides are charged, lines 22-26); and

perforating one or more sections of said sticker print medium (column 3, lines 25-28).

Floegel et al. do not disclose depositing an electrostatic charge on said sticker print medium with a charge donor after said printing of said user-selected image, wherein said charge donor is separate from, and not a part of, said sticker print medium.

However, Chamberlain discloses depositing a charge to a print medium during mounting of the medium to a surface, wherein said charge donor is separate from, and not a part of, said sticker print medium (column 1, line 55-column 2, line 7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide an electrical charge on the medium in the manner taught by Chamberlain. The reason for performing the modification would have been to increase the strength of attraction or adhesion when mounting the medium (column 2, lines 1-2).

8. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain as applied to claim 1 above and further in view of Suzuki et al. (U.S. 4,882,621).

Floegel et al. as modified by Chamberlain disclose everything claimed with the exception of reversing the image when printing it.

Suzuki et al. discloses a printing device which uses a mode setting switch (16) to enable a mirror image converting circuit (4) to perform a mirror image conversion on data from a host apparatus when transparencies are used as the recording medium, such that the image may be viewed normally after printing (column 2, lines 43-47 and column 3, lines 36-50).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the teachings of Suzuki et al. into the invention of Floegel et al. as modified by Chamberlain. The reason for performing the modification would have been to enable image data to appear in the proper orientation when printing on a transparent media.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Floegel et al. in view of Chamberlain and Suzuki et al. as applied to claim 2 above, and further in view of Naik et al. (U.S. 5,579,446).

Floegel et al. as modified do not disclose the host computer with a printer driver performing the reversing operation of the image.

However, Naik et al. discloses a host computer which performs image processing, then sends the processed image to the printer through a printer driver (fig. 1, column 5, lines 34-41).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the invention of Floegel et al. as modified to perform the processing using a printer driver of the host computer. The reason for performing the modification would have been to reduce the cost and complexity of the printing apparatus by performing computations using the host computer.

10. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chamberlain in view of Greenberg (U.S. 3,589,507).

Chamberlain discloses an electrostatic sticker kit comprising:

a kit including:

at least one blank sheet of an electrostatic sticker print medium (column 1, lines 50-54, the sticker was blank before it was printed on); and

a charge donor other than said sticker print medium for depositing an electrostatic charge on either side of said sticker print medium after said sticker print medium has been printed with an image (column 1, line 55-column 2, line 7);

wherein said at least one blank sheet of sticker print medium and said charge donor are associated together in said kit (the sticker and the charge donor could be considered part of a kit which allows a sticker to be reliably attached to a structure);

wherein said sticker print medium is made of vinyl (column 1, lines 21-22, Koroseal is one of the most popular forms of vinyl);

wherein said sheet of print medium is perforated to define a plurality of sticker panes (column 2, lines 45-52); and

wherein said sticker print medium is transparent (column 3, lines 19-24).

Chamberlain does not expressly disclose the sticker packaged in a kit.

Greenberg disclose packaging a display device in a kit (fig. 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to package the invention of Chamberlain, as suggested by Greenberg. The reason for performing the modification would have been to facilitate sale to an end user.

11. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rubino in view of Greenberg.

Rubino discloses a method comprising providing an electrostatic sticker kit, said providing an electrostatic sticker kit comprising providing a kit containing at least one blank sheet of an electrostatic sticker medium and a charge donor, other than said sticker medium, for depositing an electrostatic charge on either side of said sticker medium (abstract), wherein said at least one blank sheet of an electrostatic sticker print medium and said charge donor are associated together to form said kit. Further the sticker medium is capable of use in a printing device and was used in such a device to produce a decorative image thereon.

Rubino does not expressly disclose the sticker packaged in a kit.

Greenberg disclose packaging a display device in a kit (fig. 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to package the invention of Rubino, as suggested by Greenberg. The reason for performing the modification would have been to facilitate sale to an end user.

Response to Arguments

12. Applicant's argument regarding the 112 1st. paragraph rejection of claims 16-19 and 25 has been considered and is respectfully deemed not persuasive. Applicant is not entitled to the definition of the term kit as a packaged set of materials. This is not the

broadest reasonable definition for the term. Further, applicant's narrower definition cannot in any way be consistent with the specification since the specification provides no definition for the term, nor does it make any mention of packaging the materials together.

Applicant's argument that the claims as amended support the definition of the items packaged in a kit is respectfully a circular argument. Applicant's argument requires the new matter added into the claim to support the more narrow definition.

It has been clearly established quite recently in the courts that words of the claim are generally given their *ordinary* and *customary* meaning, unless it appears from the written description that they were used differently by the applicant. Where an applicant chooses to be his or her own lexicographer and defines terms with special meanings, he or she must set out the special definition explicitly and with "reasonable clarity, deliberateness, and precision" in the disclosure to give one of ordinary skill in the art notice of the change. See *Teleflex Inc. v. Ficosa North America Corp.*, 299 F.3d 1313, 1325, 63 USPQ2d 1374, 1381 (Fed. Cir. 2002), *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342, 60 USPQ2d 1851, 1854 (Fed. Cir. 2001), and MPEP 2111.01.

Applicant's original disclosure does not define the term kit at all thus the term is given its ordinary and customary meaning in accordance with recent case law. Further any definition added into the claims or specification to further narrow this definition is new matter.

Applicant's argument regarding the Floegel reference has been considered and is respectfully deemed not persuasive. Floegel states that "such sheets can be

generated by passing the plastic sheet through an electric field" (C 1, L 58-61). This constitutes depositing a charge on the sheet. Further, it is irrelevant how the charge was provided on the sheet of Floegel since the claims are directed towards an apparatus. All that is required by the claims is that a charge appear on the sheet. How the charge is applied, whether it is an inherent property of the sheet, or if it was deposited, are matters directed towards a manufacturing method of the sheet which is given no weight in apparatus claims.

Applicant's argument regarding the Longtin reference has been considered and is respectfully deemed not persuasive. As stated previously, limitations directed to how the charge appears on the medium do not further limit the apparatus claims. Further, Longtin discloses that the charge is on the medium while it is blank and covered with a backing, since Longtin discloses that the backing protects the medium while it is being manufactured and is stuck to the medium by the electric charge (column 1, lines 22-33).

Applicant's argument regarding the combination of Floegel and Chamberlain was addressed previously in the advisory action mailed 4 June 2003. It is reproduced below for applicant's convenience.

Applicant's argument that the combination of Floegel and Chamberlain does not increase the strength of attraction or adhesion when mounting the medium is not found persuasive. Chamberlain teaches that the medium inherently carries an electric charge (column 1, lines 24-25) and that the electrical effect is increased by rubbing the medium with a soft material such as silk or wool. It is the teachings of the prior art which determine the level of ordinary skill in the art, not applicant's statement which has no

supporting evidence. Further Chamberlain's statement is not merely a hypothesis, but rather Chamberlain states that "I have found also that the strength of the attraction or adhesion can be increased by rubbing the element or elements, after they are in place, with a soft material such as silk or wool", which suggests that this was discovered and proven through experimentation. The prior art teaches that an object which inherently has an electric charge can have its charge increased when by rubbing it with a charge donor such as wool. What Chamberlain is teaching is that the inherent electric charge on the object provides a force of electrical attraction, but by rubbing the object with a charge donor, additional charges can be transferred to the object to increase the force of electrical attraction. This is not contrary to the basic principles of electrostatics.

Applicant's argument regarding the combination of Chamberlain and Greenberg has been considered and is respectfully deemed not persuasive.

In Chamberlain, the media is inherently blank prior to printing.

Further one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's arguments regarding the combination of Rubino and Greenberg have been considered and are respectfully deemed not persuasive. The sheet of Rubino is blank since it is glued to a decorative article for mounting. Further, the sheet is a sticker print medium since it is used for its adherent properties and since it is a media which

may be used in a printer. Applicant's argument regarding packaging the materials together in a kit fails to consider the combination and attacks the references individually.

Conclusion

13. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (571)272-2147. The examiner can generally be reached Monday through Friday from 9:00 a.m. to 5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier, can be reached at (703) 308-4896. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 2853

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



JH

February 18, 2004



Thinh Nguyen
Primary Examiner
Technology Center 2800